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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,594

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EXAMINER

WAITS, ALAN B

ART UNIT

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3656

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,594	<b>Applicant(s)</b> HEBENSTREIT ET AL.	
	<b>Examiner</b> ALAN B. WAITS	<b>Art Unit</b> 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11, 13-18 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 13-18 and 21-27 is/are rejected.
- 7) ☒ Claim(s) 28 and 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on June 15, 2009 for a Continued Examination (RCE) is accepted and a continued prosecution application has been established. An action on the RCE follows.

### ***Claim Objections***

2. Claim 11 is objected to because of the following informalities: the recites the term "it". Perhaps "it" should be replaced with --said switch module--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 21 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21 and 27 recite the limitation "the axial force can be applied". The phrase "can be" implies that the limitation following it is optional. It is unclear if the limitation following the "can be" is necessary.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 11, 13-18 and 21-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirschfeld et al USP 6892602.

Re clm 11:

- A steering spindle (3, fig 1) which is mounted in a casing tube (2, fig1) so as to be rotationally movable
- A switch module (10, fig 1) which is held immovably with respect to the rotational movement of the steering spindle and is fixed radially and axially on the casing tube
- The switch module is supported on a bearing (9, fig 1) arranged on the steering spindle
- The switch module comprises a centering device (fig 3) [which, under a force which is oriented coaxially with respect to the longitudinal axis of the steering spindle, fixes the switch module on the casing tube and clamps it radially.]
- The centering device comprises a stator (11, fig 1) and clamping jaws (13, fig 1)
- An elevation (portion of 15 between the bend and where it connects to 13, fig 3) protrudes from a face (inside portion of 15 between bend and the free end, fig 3) of a first clamping jaw which faces the casing tube (the inside face of 13 faces casing tube, fig 3)

Re clm 13:

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- The stator is connected to the bearing (fig 1)

Re clm 14 & 15:

- The stator is connected to each clamping jaw via a spring element (19, fig 1)

Re clm 16:

- Each clamping jaw is in contact with the casing tube by way of a support (portion of 13 that holds 15 in place, fig 3)

Re clm 17:

- A second face (outside facing portion of 15, fig 3) of the clamping jaw which faces the stator extends obliquely with regard to the longitudinal axis of the steering spindle

Re clm 18:

- The inner face (inside of 11, fig 1) of the stator extends parallel to the oblique face of the clamping jaw

Re clm 21:

- The axial force can be applied by means of a steering wheel bolt (4, fig 1)

Re clm 22:

- A steering spindle (3, fig 1) which is mounted in a casing tube (2, fig1) so as to be rotationally movable
- A switch module (10, fig 1) which is held immovably with respect to the rotational movement of the steering spindle and is fixed radially and axially on the casing tube

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- The switch module is supported on a bearing (9, fig 1) arranged on the steering spindle
- The switch module comprises a centering device (fig 3) [which, under a force which is oriented coaxially with respect to the longitudinal axis of the steering spindle, fixes the switch module on the casing tube and clamps it radially.
- The centering device comprises a stator (11, fig 1) and clamping jaws (15, fig 1)
- A leaf spring (one of the 15, fig 1) which engages in a cut-out (recess, col 5 lines 38-50) of the casing tube is provided on the stator (11, fig 1)
- The cut-out provides an opening in the casing tube through which the leaf spring protrudes radially toward the steering spindle (col 3, lines 38-50)

Re clm 23:

- Each clamping jaw is in contact with the casing tube by way of a support (20, fig 1)

Re clm 24:

- A first face (15, fig 1) of a first clamping jaw which faces the stator extends obliquely with regard to the longitudinal axis of the steering spindle

Re clm 25:

- The inner face (inside of 11, fig 1) of the stator extends parallel to the oblique face of the clamping jaw

Re clm 26:

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- An elevation protrudes from a second face (outer portion of 15, fig 3) of a clamping jaw which faces the casing tube (the inside face of 13 faces casing tube, fig 3)

Re clm 27:

- The axial force can be applied by means of a steering wheel bolt (4, fig 1)

Regarding the functional recitation(s) in the claim(s) above denoted by the “[ ]” the examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all the claimed structural limitations and therefore anticipates the claim. See MPEP 2114. Additionally, the apparatus is capable of performing the claimed functions.

### ***Response to Arguments***

7. Applicant's arguments filed June 15, 2009 have been fully considered but they are not persuasive.

Applicant argues that Hirschfeld does not disclose an elevation protrudes toward the casing tube from a first face of a first clamping jaw that faces the casing tube. Applicant further argues that the 15 protrudes away from the casing tube. The examiner disagrees. From the reference frame of the end of the tongues (portion between the free end of 15 and the bend in 15, fig 3), the tongue 15 does in fact protrude toward the case.

Although the prior art has remained the same, the interpretation has changed.

With regard to Applicant's argument regarding the cut-out, Applicant is directed to the new interpretation in the rejection above as well as the two paragraphs preceding the claims in Hirschfeld.

***Allowable Subject Matter***

8. Claims 28 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Papandreou USP 6318756 discloses a similar device to applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN B. WAITS whose telephone number is (571)270-3664. The examiner can normally be reached on Monday through Friday 7:30 am to 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alan B Waits/  
Examiner, Art Unit 3656

/Richard WL Ridley/  
Supervisory Patent Examiner, Art Unit 3656